

Remarks

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing amendment, claims 10, 11, 14, 17, 18, 25-27, 30-36, and 39-42 are pending in the application, with claims 10, 25, and 32 being the independent claims. Claims 18 and 42 are amended by the foregoing amendment to correct minor informalities and not to overcome prior art. These changes are believed to introduce no new matter, and their entry is respectfully requested. No claims are sought to be cancelled. No new claims are sought to be added. Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Double Patenting Rejection

Claims 10-11, 14, 17-18, 25-27, 31-36, and 39-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25, 29-31, and 34-35 of U.S. Patent No. 6,377,315 ('315 patent).

Applicants have filed a Terminal Disclaimer in compliance with 1.321(c) to obviate the double patenting rejection. Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Rejections under 35 U.S.C. § 102

On page three of the Office Action, claims 10, 11, 17, 18, 25-27, 30-36 and 39-42 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent

6,400,416 to Tomasz (herein "Tomasz"). Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

The current application 09/766,048 (hereinafter '048 application) claims the benefit of U.S. Provisional Patent Application No. 60/108,459 (hereinafter '459 application), which was filed on November 12, 1998. Support for the independent claims 1, 10, and 32 of the current '048 application can be found in the '459 application at least on the pages stamped 137-138, 142, 33-36, and the page titled "Fully Integrated Dual Conversion CATV Tuner Architecture." (See, '459 application)

The Tomasz reference was filed on April 9, 1999. The '459 Application was filed on November 12, 1998. Thus, the current '048 application predates the filing date of the Tomasz reference by claiming priority to the '459 application. Therefore, the Tomasz reference is not prior art against the pending claims and Applicants request that Tomasz be removed from consideration. Accordingly, Applicants respectfully request the rejection of independent claims 10, 25, and 32 under 35 U.S.C. § 102(e) be removed and that these claims and their respective dependent claims 11, 14, 17-18, 26-27, 30-31, 33-36, and 39-42 be passed to allowance.

Rejections under 35 U.S.C. § 103

On page five of the Office Action, claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tomasz in view of US Patent No. 6,177,964 to Birleson *et al* (herein "Birleson"). Applicants respectfully traverse this rejection and respectfully request this rejection be removed and this claim be passed to allowance.

As discussed above, Tomasz is not prior art against the pending claims. Accordingly, Applicants respectfully request this rejection of claim 14 under 35 U.S.C. § 103 be removed and that this claim be passed to allowance.

Other Matters

Applicants have amended claims 18 and 42 to correct minor informalities. These amendments are supported by the specification and have not been made to overcome prior art. Also, these amendments do not narrow the scope of protection. Thus, it is respectfully requested that all amendments be entered by the Examiner.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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